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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/825,574

04/15/2004

Kurt Brooks Uhler

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EXAMINER

HU, KANG

ART UNIT

PAPER NUMBER

3715

MAIL DATE

DELIVERY MODE

07/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/825,574	Applicant(s) UHLIR ET AL.	
	Examiner KANG HU	Art Unit 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 11-14, 17-19, 23 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8, 11-14, 17-19, 23 and 36-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

In view of the appeal brief filed on 12/09/2008, PROSECUTION IS HEREBY REOPENED.

New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715

After careful consideration of comments and arguments provided in applicant's appeal brief dated 12/09/2008, the examiner is withdrawing the finality of the final rejection dated 5/14/2008. Currently claims 2-8, 11-14, 17-19, 23 and 36-38 are pending in the application.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 2-8, 11-14, 17-19, and 36 are rejected under USC 101, the claimed invention is directed to non-statutory subject matter. In order for a claimed process to be considered statutory it must be: (1) tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing. The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility; the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity; and the transformation must be central to the purpose of the claimed process. Claim 36 as recited do not act upon a physical object so as to provide a transformation of that object into a different state or thing. Further the claims do not recite a tie to a particular machine or apparatus. The recitation of "using a geographic database" is nominal recitations and do not recite nor require the use of any specific machine or apparatus.

Claims 2-8, 11-14, 17-19 are rejected for its dependency upon claim 36 for failing to correct these deficiencies. As such, they are rejected for the same reason.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-8, 11-14, 17-19, 23 and 36-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claims 36-38, each of the claims recite similar limitations of “using a geographic database to compare geographic features of two different geographic area; comparing a first performance to a second performance.” The claim is indefinite for failing to particularly point out and distinctly claim the subject matter as the limitations are ambiguous for having steps that’s disjointed from each other, each of the steps in the method are not interrelated in a logical manner. The two different limitations of comparing different geographic area and comparing different performances are not tied together. It is unclear how the two components are intended to perform together within the method.

Re claim 4, the claim recites "selecting the second course to be equivalent to the first course by applying a personal factor selected from a group consisting of: age, gender, and physical handicaps.” The claim is indefinite as these factors are used to compare performances of each participant on a course and does not make the second course equivalent to the first course.

Claims 2-8, 11-14, 17-19, and 23 are rejected for their incorporation of the above through their dependency of claims 36 and 37.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2-8, 11-14, 17-19, 23 and 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Muendel (WO 01/42809 A2).

Re claims 36-38, Muendel teaches a method for facilitating a first performance by a participant in an event that includes movement along a first course located in a first geographic area, the method comprising:

using a geographic database that contains data that represents geographic features in the first geographic area to compare the geographic features of the first course to the geographic features of a second course located in a second geographic area different from the first geographic location (page 18, line 23 - page 19, line 2: athletes preparing for a race with a particular elevation profile might benefit from software that uses the DEM database to engineer a local training route that has a similar elevation profile to that of the race, and the GPS device could then guide them along that course);

comparing the first performance to a second performance, wherein the second performance is along the second course (page 27, line 23- page 28, line 20);

and providing an indication of the comparing of the first and second performances to the participant (page 28, line 20: a winner's flag).

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Muendel further teaches:

Re claim 2, the event is one selected from a group consisting of: running, cross-country skiing (page 1, lines 16-18).

Re claim 3, selecting the second course to be equivalent to the first course by applying a factor selected from a group consisting of elevation changes (page 18, lines 23-25).

Re claim 4, selecting the second course to be equivalent to the first course by applying a personal factor selected from a group consisting of age (page 28, line 17).

Re claims 5 and 6, determining positions of the first participant during the first performance (claim 5) and the positions of the first participant are determined using a first positioning device (claim 6) (page 24, lines 13-25).

Re claims 7 and 13, the first/second positioning device is selected from a group consisting of: a global positioning system unit (page 24, line 18).

Re claims 8 and 14, the positions of the first/second participant are transmitted as data wirelessly from a first/second communications device located with the first/second participant (page 21, line 11: IR type interface).

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Re claims 11 and 12, determining positions of a second participant during the second performance (claim 11) and wherein the positions of the second participant are determined using a second positioning device (claim 12) (page 28, lines 4-15).

Re claim 17, the second performance is by the first participant, but occurred at a time previous to a time of the first performance (page 10, line 5: other courses).

Re claim 18, the indication is provided to the first participant during the event (page 14, line 20 – page 15, line 7).

Re claim 19, the indication is provided to the first participant during the event via a wireless communications device (page 10, line 9: personal trainer).

Re claim 23, the participant's performance is monitored by a positioning unit that determines positions of the participant in the first geographic area while the participant is moving along the first course in the first geographic area (page 10, lines 9-25).

Response to Arguments

7. Applicant's arguments, see pages 4-13 of applicant's appeal brief, filed 12/09/2008, with respect to the rejection(s) of claim(s) 2-8, 11-14, 17-19, 23 and 36-38 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Muendel.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Root et al. (US 6,013,007)

Kirson et al. (US 6,072,751)

Bovay (US 4,523,204)

Ishiguro (US 7,085,648 B2)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KANG HU whose telephone number is (571)270-1344. The examiner can normally be reached on 8-5 (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-262-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/
Primary Examiner, Art Unit 3715

/K. H./
Examiner, Art Unit 3715